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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/619,888	07/15/2003	Paul J. Thompson	23,369-153	7451

23452 7590 04/19/2005

PATENT DEPARTMENT  
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EXAMINER

PREBILIC, PAUL B

ART UNIT	PAPER NUMBER
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3738

DATE MAILED: 04/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary****Application No.**

10/619,888

**Applicant(s)**

THOMPSON, PAUL J.

**Examiner**

Paul B. Prebilic

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 21 January 2005.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 54-105 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 95-105 is/are allowed.
- 6) ☒ Claim(s) 54-56, 58-80, 82, 83 and 85-94 is/are rejected.
- 7) ☒ Claim(s) 57, 81 and 84 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

***Terminal Disclaimer***

The terminal disclaimer filed on January 21, 2005 disclaiming the terminal portion of any patent granted on this application, which would extend beyond the expiration date of US Patents 6,689,122 and 6,592,617 has been reviewed and is accepted. The terminal disclaimer has been recorded.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 54-56, 60-64, 66-69, 73-77, 80, 82, 83, and 85-94 are rejected under 35 U.S.C. 102(e) as anticipated by Schmitt et al (US 5,697,969). Schmitt et al anticipates the claim language wherein the structural strands are the non-absorbable strands (e.g. polyester monofilaments or polyethylene terephthalate (i.e. DACRON) (32,42)), which are heat-set within the braid to retain their shape within the braid, and thus, they have a helical shape and tubular profile; see Figures 3 to 10, Examples 2 to 6 and column 2, lines 8-22.

Regarding claim 55, the materials claimed are some of the same materials that are disclosed by Schmitt et al, and thus, the materials of Schmitt et al are considered to be inherently resilient and ductile to the extent that Applicant's materials are.

Furthermore, the Examiner asserts that stainless steel, as disclosed by Schmitt et al, is inherently a resilient and ductile material; see column 2, lines 8-22 of Schmitt et al.

With regard to claims 68 and 90, stainless steel is the metal strand material required by the claim language.

Claim 65 is rejected under 35 U.S.C. 103(a) as being unpatentable over Schmitt et al (US 5,697,969) in view of Pinchuk (US 5,092,877). Schmitt et al fails to teach the use of drug eluting fibers therewith. Pinchuk, however, teaches that it has been known to use drug-eluting fibers in similar devices; see column 7, lines 9-34. Hence, it is the Examiner's position that it would have been obvious to use drug-eluting fibers in the Schmitt et al invention so that, for example, the restenosis of the blood vessel in the vicinity of the implant could be further prevented by the drug being released.

Claims 70-72 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schmitt et al (US 5,697,969) alone.

With regard to claims 70-72, Schmitt et al fails to set forth the particular filament size range as claimed. However, the Examiner posits that the claimed filament size range would have been obvious in view of Schmitt et al, which uses multi-filament yarns of the same denier in the same environment of use as the Applicant. Therefore, since no criticality of unexpected result has been shown for the particular filament size range claimed, the Examiner posits that it would have been obvious and a matter of design choice to select one.

Claims 78-79 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schmitt et al (US 5,697,969) in view of Engelson et al (US 5,423,849). Schmitt fails to

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disclose the use of a radiopaque fiber therewith. Engelson et al, however, teaches that it has been known to use radiopaque fibers in similar braided implants. Hence, it is the Examiner's position that it would have been obvious to interbraid a radiopaque fiber into the braid of Schmitt et al for the same reasons that Engelson et al does the same and so that the Schmitt et al device would be readily viewable during implantation and after by an X-ray apparatus.

Claims 58 and 59 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schmitt et al (US 5,697,969) in view of Wallsten (US 5,061,275). Schmitt fails to disclose the use of a catheter to insert the graft thereof into the body. Wallsten, however, teaches that it has been known to do such; see Col. 15, line 17-35. Hence, it is the Examiner's position that it would have been obvious to use a catheter to insert the graft of Schmitt et al into the blood vessel site to be treated so that the graft is protected from picking up debris prior to insertion at the site of interest.

#### ***Allowable Subject Matter***

Claims 57, 81, and 84 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 95-105 are allowed over the prior art of record.

#### ***Response to Arguments***

Applicant's arguments filed January 21, 2005 have been fully considered but they are not persuasive.

Applicant argues that Schmitt does not anticipate the claim language because the heat setting process step used to make the device was performed after assembly instead of before as claimed; see page 13 of the January 21, 2005 response. However, the Examiner asserts that process limitations in product claims are only given weight to the extent that they clearly result in a different final product; see MPEP 2113, which is incorporated herein by reference. In the present claims, however, the heat setting process does not clearly result in a different product, and thus, the Schmitt device is reasonably considered to be identical to the presently claimed invention.

In response to the traversal that the structural strands of Schmitt are not made of the claimed materials, the Examiner respectfully disagrees and directs Applicant to column 2, lines 8-22 where stainless steel is disclosed.

The remaining arguments, pertaining to the Section 103 rejections, rely on the alleged deficiencies of Schmitt. However, since Schmitt teaches a heat set strands and reasonably a material that is identical to the claimed invention, Applicant's arguments are considered unpersuasive for the reasons set forth earlier.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the

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shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Applicant should specifically point out the support for any amendments made to the disclosure, including the claims (MPEP 714.02 and 2163.06). Due to the procedure outlined in MPEP 2163.06 for interpreting claims, it is noted that other art may be applicable under 35 USC 102 or 35 USC 103(a) once the aforementioned issue(s) is/are addressed.

Applicant is respectfully requested to provide a list of all copending applications that set forth similar subject matter to the present claims. A copy of such copending claims is respectfully requested in response to this Office action if the application is not stored in image format (i.e. the IFW system) or published.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Paul B. Prebilic whose telephone number is (571) 272-4758. He can normally be reached on 6:30-5:00 M-Th.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, McDermott Corrine can be reached on 571-272-4754. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Paul Prebilic  
Primary Examiner  
Art Unit 3738